



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,928	01/09/2002	Dah-Shiarn Chiao	100.006	9600

7590 12/18/2003
David M. O'Neill
786 Townsend Avenue
New Haven, CT 06512

EXAMINER

CONLEY, SEAN E

ART UNIT PAPER NUMBER

1744

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,928

Applicant(s)

CHIAO ET AL.

Examiner

Sean E Conley

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2002 and 23 April 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-98 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-98 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-48, drawn to a scent- and multimedia-bearing card, classified in class 369, subclass 15.
 - II. Claims 49-54, drawn to a method of releasing scent from a scent-bearing card, classified in class 422, subclass 1.
 - III. Claims 55-57, drawn to a method of using a scent- and multimedia-bearing disk having electrostatic scent release, classified in class 422, subclass 4.
 - IV. Claims 58-60, drawn to an electrostatic scent storage release unit for use with scent- and multimedia-bearing disks, classified in class 422, subclass 305.
 - V. Claims 61-65, drawn to a scent- and multimedia-bearing disk with electrostatic scent release means, classified in class 352, subclass 85.
 - VI. Claims 66-69, drawn to a scent- and multimedia-bearing disk with microencapsulated scent that is released by laser energy, classified in class 422, subclass 124.
 - VII. Claims 70-76, drawn a scent release monitoring system and method for use in scent release systems and scent release and multimedia playback systems, classified in class 422, subclass 119.

- VIII. Claims 77-89, drawn to an editing apparatus and method for creating digital scent release and multimedia playback control information, classified in class 386, subclass 52.
- IX. Claims 90-98, drawn to a multimedia playback goggle and electrostatic scent release mask, classified in class 700, subclass 239.

The inventions are distinct, each from the other because of the following reasons:

- 2. Invention I is unrelated to inventions II-IX. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the invention of Group I requires a scent- and multimedia-bearing card having a scent storage medium, an encapsulated multimedia storage medium, and scent release and multimedia playback control information for use by a scent release and multimedia playback system. None of the other groups of inventions requires a card having a scent storage medium, an encapsulated multimedia storage medium, and scent release and multimedia playback control information.
- 3. Invention II is unrelated to inventions I and III-IX. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the invention of Group II is a method for releasing scent from a scent-bearing card, the scent-bearing card storing scent in a scent storage

unit, and the scent being released by a scent release unit connected to the scent storage unit. The method comprises moving a scent from the scent storage unit to the scent release unit, opening the cover of the scent release unit to permit scent to release, energize the electrostatic scent release apparatus, allowing energized scent to escape, and creating an air flow near the scent-bearing card to assist in venting of the released scent. None of the other groups of inventions require the method steps as recited in Group II for the release of scent from a scent bearing card.

4. Invention III is unrelated to inventions I-II and IV-IX. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the invention of Group III requires the steps of receiving an input command from the user to initiate scent and multimedia release, recovering digital scent release and multimedia playback control information corresponding to the user input, initiating multimedia recovery and playback, interpreting the identity, time, and duration of scent release reflected in the digital scent release and multimedia control information, and finally releasing the proper scents at the proper time and for the proper duration from the disk using electrostatic scent release. None of other groups of inventions requires the method steps as recited in Group III for releasing scent and multimedia information. More specifically, none of the other inventions requires recovering digital control information.

5. Invention IV is unrelated to inventions I-III and VI-IX. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the invention of Group IV requires a scent storage reservoir, a scent release plenum, a capillary tube connecting the reservoir and plenum, and an electrostatic discharge apparatus for ionizing scent. None of the other groups of inventions requires a capillary tube connecting a scent reservoir and plenum and further having an electrostatic discharge apparatus for ionizing scent.

6. Invention V is unrelated to inventions I-IV and VI-IX. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the invention of Group V requires a circular disk substrate having a scent storage housing on one side and an optical multimedia storage on the other side of the disk. The scent storage region further comprises an electrostatic scent release unit positioned within the scent storage housing. The electrostatic scent release unit comprising a discharge needle and an electrostatic potential supply wiring. None of the other groups I-IV and VI-IX requires a circular disk having an electrostatic scent release unit located in a scent storage region on one side of the disk while the optical multimedia storage is located on the other side of the disk.

7. Invention VI is unrelated to inventions I-V and VII-IX. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the invention of Group VI requires a circular disk substrate having an optical storage medium and a microencapsulated scent storage region, wherein the microencapsulated scent is released by laser energy. None of the other groups of inventions require a microencapsulate scent storage means on a circular disk that is released by laser energy.

8. Invention VII is unrelated to inventions I-VI and VIII-IX. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the invention of Group VII requires a scent release detection means, a scent release rate determination means, a scent release event duration monitoring means, a scent release event information storage means. None of the other groups of inventions require a means for detecting, monitoring, and recording a scent release event.

9. Invention VIII is unrelated to inventions I-VII and IX. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the invention of Group VIII requires an editing

apparatus for multimedia segment selection, timeline creation, scent release event addition means, a memory medium, and a recording means. None of the other groups is related to an editing apparatus.

10. Invention IX is unrelated to inventions I-VIII. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the invention of group IX requires a multimedia playback goggle and electrostatic scent release mask for releasing scent directly to the nose and/or mouth of a user. None of the other groups of inventions is related to a goggle or mask for delivering multimedia and scent to a user.

11. Because these inventions are distinct for the reasons given above and the search required for any one of Groups I-IX is not required for any of the other groups, restriction for examination purposes as indicated is proper.

12. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

13. A telephone call was made to David O'Neill on November 24, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

14. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Conley, whose telephone number is (703) 305-2430. Beginning December 16, 2003, the examiners phone number will change to (571) 272-1273. The examiner can normally be reached on Monday-Friday 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Robert Warden, can be reached at (703) 308-2920. The Unofficial fax phone number for this group is (703) 305-7719. The Official fax phone number for this

Application/Control Number: 10/043,928
Art Unit: 1744

Page 9

Group is (703) 872-9310. The direct fax number to the examiner is (703)-746-8859. Beginning December 16, 2003, the direct fax to the examiner will change to (571) 273-1273.

When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite the processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [robert.warden@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist, whose telephone number is (703) 308-0661.

Sean E. Conley
Patent Examiner
AU 1744

SEC *fe*
December 15, 2003

Robert J. Warden, Sr.
**ROBERT J. WARDEN, SR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700**